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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/677,880	10/02/2003	Ulrich Muller	0329-0009.01	9686

26568 7590 05/22/2006

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EXAMINER

BALI, VIKKRAM

ART UNIT

PAPER NUMBER

2624

DATE MAILED: 05/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.



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**MAY 22 2006**  
**Technology Center 2600**

**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 10/677,880  
Filing Date: October 02, 2003  
Appellant(s): MULLER ET AL.

Andrew G. Kolomayets  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 3/23/2006 appealing from the Office action mailed 9/28/2005.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

5,367,378

HARDING et al.

11-1994

Pirlet, et al., "A Non contact system for measuring hot strip flatness" Iron and steel engineer, July 1983, pp. 45-50

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 8-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Harding et al (US 5367378) in view of A non contact system for measuring hot strip flatness, by Pirlet et al.

With respect to claim 8, Harding discloses highlighted panel inspection in that as claimed "projecting a shadow in the form of a line pattern onto said metal strip", (see Abstract and figure 1 and also see col. 3, lines 28-30, wherein it shows that a grid 12, is a light box which has a spaced opaque lines and those lines are backlit by a light source, and therefore, a shadow gets projected on to the object); and "detecting said line pattern on said metal strip with a camera", (see Abstract and figure 1, numerical 14 camera for observing the pattern). However, he fails to disclose that the hot metal strip is "moving" as claimed in claim 8. Pirlet in teaches an inspection of the moving hot metal strip (see page 45 col. 1) as claimed.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the inspection method to use for the measurements of the panels as described by Harding by introducing the method of measuring the shape of the moving hot metal strip as taught by Pirlet in a non contact system for measuring the hot strip flatness, as both of these two references are solving the same problem of measuring the metal strip. This modification will provide an apparatus that will measure different thickness of the moving metal strips to detect any discrepancies.

With respect to claim 9, Harding further discloses "the line pattern detected by said camera is compared continuously by a computer with a reference pattern", (see Abstract first three lines and figure 1 for the apparatus) as claimed.

With respect to claim 10, Harding further discloses "the line pattern detected by said camera is used for control of a finishing train", (see Abstract, lines 2-3, wherein, the pattern observed by the camera is utilized for the evaluation of the metal strip "control of a finishing train") as claimed.

With respect to newly added claim 14, Harding further discloses "projecting a shadow comprises using a projector to project through a slide", (see col. 3, lines 28-30, wherein, a regularly spaced opaque lines is read as the slide) as claimed.

Claims 11-13 and 15 are rejected as claims 8-10 and 14, because claims 11-13 and 15 are claiming similar subject matter as claims 8-10 and 14 respectively.

#### **(10) Response to Argument**

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). And, in the instant case, reference Harding discloses highlighted panel inspection in that as claimed projecting a shadow in the form of a line pattern onto said metal strip, as can be seen from Abstract and figure 1 and also see col. 3, lines 28-30, wherein it shows that a grid 12, is a light box which has a spaced opaque lines and those lines are backlit by a

light source, and therefore, a shadow gets projected on to the object, and discloses detecting said line pattern on said metal strip with a camera, see Abstract and figure 1, numerical 14 camera for observing the pattern. And the reference of Pirlet teaches an inspection of the moving hot metal strip, as seen from page 45 col. 1. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the inspection method to use for the measurements of the panels as described by Harding by introducing the method of measuring the shape of the moving hot metal strip as taught by Pirlet in a non contact system for measuring the hot strip flatness, as both of these two references are solving the same problem of measuring the metal strip. This modification will provide an apparatus that will measure different thickness of the moving metal strips to detect any discrepancies.

Applicant argues that the "metal strips contain many irregularities, which appear as random darkened areas on the surface" but this is not claimed in the claims. Also, applicant argues that the "hot metal" is inspected. But, claims 11-13 and 15 did not claim "hot metal".

The declaration filled on 4/20/2005, is made of record. The declaration is attacking the reference individually. And, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Also, the "hot metal" in paragraph 6 is not claimed in Claims 11-13 and 15. And, the declaration fails to show any facts, and provides only the opinions. And, in this case the person making the declaration stand to benefit from

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the statements made in the declaration on his expert opinions, and as there was no factual evidence provided the declaration if found to be insufficient (see MPEP 716).

**(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

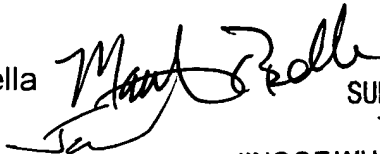
Respectfully submitted,

Vikkram Bali

  
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